UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,797	09/29/2003	Gouichi Nishizawa	81864.0026	2234

26021 7590 11/27/2006

HOGAN & HARTSON L.L.P.
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

EXAMINER	
SHEEHAN, JOHN P	
ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/675,797	NISHIZAWA ET AL.	
	Examiner	Art Unit	
	John P. Sheehan	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-6 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 5/06 7/06.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed July 19, 2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of Chinese patent document No. 1,258,082 that is not in the English language. This document has been placed in the application file, but the information referred to therein has not been considered.

Claim Interpretation

2. Applicants are advised that in claim 1, line 6, the phrase, "4% or less by weight (excluding O) of Co", has been interpreted by the Examiner to mean that the cobalt content is greater than zero but does not exceed 4%.

3. There is no language in the applicants' claims to preclude the presence of Zr from the high R alloy recited in the claimed process. Accordingly, the instant claims are considered to encompass (1) the embodiment wherein both the high and low R alloys contain Zr and (2) the embodiment wherein only the low R alloy contains Zr.

4. Additionally, in view of the fact that there is no language in the claims that precludes the R rich alloy from containing boron and the use of the open terminology

"containing" (claim 1, line 12) used to describe the R rich alloy, the claims are considered to encompass the embodiment wherein the R rich phase contains boron.

Double Patenting Under 35 USC 101

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1 to 6 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 to 3 and 6 of copending Application No. 10/799,243. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

7. Claims 1 to 6 are directed to the same invention as that of claims 1 to 3 and 6 of commonly assigned Application No. 10/799,243. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this

situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Nonstatutory Obviousness Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1 to 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 to 6 of copending Application No. 10/799,243. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of these two sets of process claims overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1 to 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application Nos. 10/799,153 and 10/675,230 each in view of Takebuchi et al. (Takebuchi, US Patent No. 5,595,608, cited in the IDS submitted July 19, 2006).

'153 and '230 claim the alloy composition recited in the instant claims.

Takebuchi teaches a method of making a sintered rare earth iron boron permanent magnet comprising the steps recited in the instant claims (column 3, lines 12 to 22 and column 4, lines 9 to 14).

The claims of '153 and '230 and the instant claims differ in that the claims of '153 and '230 do not teach the process steps recited in the instant claims.

However, the application of the conventional process steps of making a sintered rare earth-iron-boron as taught by Takebuchi to make the sintered rare earth-iron-boron magnet claimed in '153 and '230, thus resulting in the instantly claimed process is considered to be obvious.

11. Claims 1 to 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,811,620 in view of Takebuchi et al. (Takebuchi, US Patent No. 5,595,608, cited in the IDS submitted July 19, 2006).

'620 claims the alloy composition recited in the instant claims.

Takebuchi teaches a method of making a sintered rare earth iron boron permanent magnet comprising the steps recited in the instant claims (column 3, lines 12 to 22 and column 4, lines 9 to 14).

The claims of '620 and the instant claims differ in that the claims of '620 do not teach the process steps recited in the instant claims.

However, the application of the conventional process steps of making a sintered rare earth-iron-boron as taught by Takebuchi to make the sintered rare earth-iron-boron magnet claimed in '620, thus resulting in the instantly claimed process is considered to be obvious.

12. Claims 1 to 6 are directed to an invention not patentably distinct from claims 1 to 6 of commonly assigned 10/799,243, 10/799,153, 10/675,230 and 6,811,620. Specifically, see the obviousness double patenting rejections set forth above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/799,243, 10/799,153, 10/675,230 and 6,811,620, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that

the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments

13. Applicants are advised that the rejections under 35 USC 102(b) and 35 USC 103 based on Yamamoto have been overcome by applicants' arguments, particularly applicants' arguments set forth on page 8 of applicants' response submitted May 22, 2006.

14. Applicant's arguments filed September 8, 2006 have been fully considered but they are not persuasive.

15. Applicants' statement of common ownership overcomes the requirement set forth on page 9 of the Office action mailed March 9, 2006. However, applicants' statement of common ownership does not overcome the nonstatutory obviousness double patenting rejection set forth on page 8 (paragraph 16) of the Office action mailed March 9, 2006.

16. In an attempt to overcome the rejection of claim 1 for double patenting under 35 USC 101 in view of claim 5, of 10/799,243, applicants have canceled claim 5 of 10/799,243 and rolled the limitations of canceled claim 5 into claim 1. In view of this, amended independent claim 1 of '243 is the now the same as canceled original

dependent claim 5. Accordingly, all of the instant claims are now subject to the 101 double patenting rejection in view of claims 1 to 3 and 6 of 10/799,243.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John P. Sheehan
Primary Examiner
Art Unit 1742

jps